

REMARKS

Claims 1-4 and 6-7 are all the claims now pending in the application. Claim 5 has been canceled and claims 6-7 newly added.

Information Disclosure Statement

The Examiner states that the Information Disclosure Statement which the Applicant filed on April 26, 2002, has not been considered because the copy is not legible. Thus, in the accompanying copy of USPTO Form 1449 returned to the Applicant with the Office Action to which Applicants now are responding, the Taiwanese reference 449,489 was not initialed by the Examiner, but has a strike through, indicating it has not been considered. The Examiner's position is not understood since the Applicant submitted a copy of both (1) an abstract and information sheet of the original Taiwanese Patent publication and (2) a copy of the corresponding U.S. Patent No. 6,227,968 with the IDS. As the corresponding and listed U.S. Patent 6,227,968 had been initialed, Applicant is withdrawing the request.

Claim Rejections - 35 U.S.C. § 112

Claims 4 and 5 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The basis for this indefiniteness is that the body structure of claims 4 and 5 are identical to the body of claim 3 and can only be distinguished by their preambles. Thus, the Examiner has not given patentable weight to the preamble of claims 4 and 5. This rejection is traversed.

The Examiner's rejection has no support under U.S. law. First, it should be noted that claim 3 is directed to a "game process method for providing each of a first player and a second player with a game". Claim 4 is directed to "an information storage medium storing a program

for providing each of a first player and a second player with a game,” while claim 5 is directed to “a program for providing each of a first player and a second player with a game.” Claims 3 and 4 are directed to distinctly different statutory categories of invention under 35 U.S.C. § 101. Claim 3 is directed to a method while claim 4 is directed to a product, namely an information storage medium. The separate patentability of these two different forms of invention was clearly recognized in the case of *In re Beauregard*, 35 U.S.P.Q.2d (BNA) 1383 (Fed. Cir. 1995). Accordingly, this rejection of claim 4 should be overcome.

With regard to claim 5, the rejection is rendered moot by the cancellation of the claim.

Finally, the Examiner’s basis for rejection, namely 35 U.S.C. § 112, second paragraph, is wholly improper. The claims on their face are clear and definite. The Examiner has not identified any feature of the claims that would lead one of ordinary skill in the art to find the invention ambiguous. The identity of text in the body of both claims does not lead to such ambiguity. Accordingly, this rejection should be withdrawn.

Claim Rejections - 35 U.S.C. § 102

Claims 1-5 are rejected under 35 U.S.C. § 102(e) as being anticipated by Suzuki et al (6,227,968). This rejection is traversed.

The present invention, particularly embodied as a game machine, is intended to provide “each of a first player and a second player with a game allowing a player to enjoy operation of the game using a controller according to game music.” The structure recited within the claim in means plus function language expressly relates to “the first player and the second player.”

Consistent with the disclosure in the specification and drawings, the system is directed to a music-oriented game having a match play mode, where two controllers (32a, 32b) are connected so that two players can enjoy a music-oriented game in a match play mode. (page 7, lines 17-25). The description of each of the two controllers is provided at page 9, beginning at line 17, with reference to Fig. 2. Each of the two competing players is assigned a controller, which is in mat form. Fig. 3 illustrates a display on a monitor that includes first player screen image area 82 and second player screen image area 84.

As explained at page 17, the timing for each player may be individually selected. At page 19, the specification teaches that a “timing table” is prepared and used as a basis for providing timing guidance to each of the players. Game operation evaluation is performed in accordance with the program illustrated in Figs. 11 and 12, as described beginning at page 25, with particular disclosure at page 27, with regard to step 106. As explained at page 30, beginning at line 5, a level for timing guidance can be changed based on the result of an evaluation of each player’s performance. Thus, a feeling of competition between the players can be increased. Each of these features in structural form is recited in claim 1, and in method form is recited in claim 3.

The patent to Suzuki et al has been cited as anticipating the claimed invention. Anticipation requires that every limitation in the claim be found in the cited reference. The several claimed features that require competition between first and second players are not found in Suzuki.

While Suzuki is directed to a dance game, its disclosure is primarily focused on the performance of a single player. Fig. 9 illustrates a case of two-person play and the disclosure at col. 9, line 6-27 briefly describes such two-person operation. More particularly, there is no teaching of a competition between two persons and an evaluation of their competitive performance.

In the absence of such disclosure, anticipation is not possible.

Even if the Examiner should assert that such competition is obvious, there is no teaching or suggestion as to how such competition may be implemented within the structure disclosed in Suzuki et al.

Finally, Applicants have added new claims 6 and 7, which are derived from original claims 1 and 2, and express the invention in a form that does not involve “means plus function” limitation.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Patent Application No. 09/931,863

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

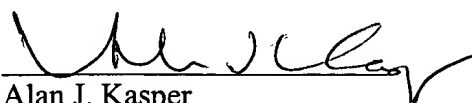
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APPENDIX
VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claim 5 is canceled.

Claims 6-7 are added as new claims.